No. 92-114

IN THE
Supreme Court of the United States
OCTOBER TERM, 1992

CARDINAL CHEMICAL COMPANY, et al.,
Petitioners,
vs.
MORTON INTERNATIONAL, INC.,
Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF *AMICUS CURIAE* OF THE AMERICAN BAR ASSOCIATION IN SUPPORT OF PETITIONERS

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QUESTION PRESENTED

Whether the Court of Appeals for the Federal Circuit errs when it vacates a declaratory judgment holding an asserted patent invalid merely because it determines that the patent is not infringed.

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STATEMENT OF INTEREST

The American Bar Association ("ABA") is a voluntary, national membership organization of the legal profession. The more than 360,000 members of the

ABA come from every state and territory and the District of Columbia.[1]

The Section of Patent, Trademark and Copyright Law ("Section") of the ABA includes over 10,000 ABA members interested and having expertise in intellectual property law. Since 1894, the ABA and the Section have contributed to the development of a system for protection of intellectual property and thereby advanced the technological development of our nation. Many members of the Section practice in the field of patent law, representing patent owners, potential infringers, and in particular persons and businesses affected by patents.

The ABA believes that the issue presented is of national public importance. By the decision below, the Federal Circuit, with its exclusive appellate jurisdiction in patent cases, continues its practice of routinely vacating declaratory judgments of patent invalidity whenever it finds noninfringement. This practice violates the public interest favoring the fair, effective, efficient, and final determination of patent claims.

Although the ABA has no interest in the outcome of the validity determination in this case, the ABA

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[1] Neither this brief nor the decision to file it should be interpreted to reflect the views of any judicial member of the American Bar Association. No inference should be drawn that any member of the Judicial Administration Division Council has participated in the adoption of or endorsement of the positions in the brief. This brief was not circulated to any member of the Judicial Administration Division Council prior to filing.

participates as *amicus curiae* to protect the public interest. The ABA views this interest with such gravity that it has adopted the following resolution:

> RESOLVED, that the American Bar Association favors, in principle, the proposition that a court of appeals, like a trial court, is not deprived of jurisdiction to determine the validity of a patent merely because the court of appeals determines that the patent was not infringed.
>
> BE IT FURTHER RESOLVED, that the American Bar Association favors, in principle, the proposition that a court of appeals should not refuse to consider a claim or counterclaim for a declaratory judgment regarding the validity of a patent merely because the court of appeals determines that the patent was not infringed.

Because the Federal Circuit's practice is diametrically opposed to the ABA's view, the ABA has a substantial interest in the question presented.

The ABA has received the consent of all parties in this case to present its views.

SUMMARY OF ARGUMENT

The Federal Circuit's practice of routinely vacating declaratory judgments of patent invalidity whenever it has found that there is no infringement is contrary to numerous public policies enunciated by this Court. The Federal Circuit's unprecedented practice violates policies favoring the invalidation of wrongfully issued patents.

finality in litigation, the orderly operation of the justice system through preservation of lower court decisions after an appeal on the merits, and the policy against needless and frivolous appeals. The Federal Circuit's practice results in needless, repetitive litigation on the resurrected patents. This repetitive patent litigation wastes the resources of the litigants, the Federal Circuit and the already heavily-burdened district courts.

That Federal Circuit's practice finds no support in this Court's decisions or in the mootness doctrine relied upon by the Federal Circuit as the basis for the practice. The Federal Circuit cannot and should not moot an invalidity claim by its decision on another claim in the same case. The Federal Circuit's interpretation of this Court's decisions to suggest otherwise is incorrect.

For these reasons, this Court should reverse the decision of the Federal Circuit, insofar as it vacates the district court's invalidity judgment without review, and remand this case to the Federal Circuit for review on the merits of the declaratory judgment of patent invalidity.

ARGUMENT

I. THE FEDERAL CIRCUIT'S PRACTICE HARMS THE PARTIES AND THE PUBLIC

A. The Practice Harms The Public

The Federal Circuit's practice of vacating declaratory judgments of invalidity when it finds no infringement violates several public policies, including: (1) the policy favoring invalidation of wrongfully-issued patents which

may hinder free competition; (2) the policy favoring the finality of judgments; (3) the policy favoring the orderly operation of the justice system, including recording and preserving lower court decisions after a trial on the merits; and (4) the policy against needless or frivolous appeals.

The first policy violated by the Federal Circuit's practice is that favoring invalidation of wrongfully-issued patents. Wrongfully-issued patents may hinder free competition in technologies which rightfully ought to be in the public domain. *See, e.g., Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969). Such a patent may have a deterrent or *in terrorem* effect and may cause a putative attacker or infringer to conclude that the demanded royalty is cheaper than the costs of litigation. *Wang Laboratories, Inc. v. Toshiba Corp.*, 793 F. Supp. 676, 678 n.4 (E.D. Va. 1992). As Learned Hand observed, a wrongfully-issued patent may act as a "scarecrow." *Bresnick v. United States Vitamin Corp.*, 139 F.2d 239, 242 (2d Cir. 1943).

To avoid these effects, this Court has recognized the public importance of invalidating wrongfully-issued patents. *Pope Mfg. Co. v. Gormully*, 144 U.S. 224, 234 (1892) ("It is as important to the public that competition should not be repressed by worthless patents, as that the patentee of a really valuable invention should be protected in his monopoly"). By routinely vacating judgments declaring patents invalid without examining the judgments on the merits, the Federal Circuit routinely resurrects "invalid" patents, which may hinder free competition.

Closely related to this first policy is the policy favoring the finality of judgments. This Court, in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 350 (1971), held that a patent once declared invalid is invalid forever.

> [A] patentee, having been afforded the opportunity to exhaust his remedy of appeal from a holding of invalidity, has had his "day in court" and should not be allowed to harass others on the basis of an invalid claim. There are few, if any, logical grounds for permitting him to clutter crowded court dockets and to subject others to costly litigation.

Id. at 339-40.

The Federal Circuit's current practice substantially eviscerates *Blonder-Tongue* and permits patentees "to harass others on the basis of an invalid claim." *Id.* at 340. Under the Federal Circuit's practice, a district court judgment of invalidity is given preclusive effect only if the Federal Circuit concludes that the defendant is an infringer. If the defendant is innocent, the invalidity judgment is vacated and afforded no preclusive effect. The patentee is then free to assert its resurrected patent against other defendants, just as was the case before this Court's decision in *Blonder-Tongue*.

The third public policy violated by the Federal Circuit's practice is that favoring the orderly operation of the justice system. That orderly operation depends on the conclusion of litigation being recorded and preserved for the future. *See In re Memorial Hosp. of Iowa County,*

Inc., 862 F.2d 1299, 1303 (7th Cir. 1988). For this reason, district court judgments should not be routinely vacated. *Id.*

The fourth public policy violated by the Federal Circuit's practice is that against needless or frivolous appeals. A patentee who has been stripped of its patent by a declaration of invalidity may -- for example, to continue its licensing revenue -- regain its patent by appealing. *See Sun-Tek Indus., Inc. v. Kennedy Sky Lites, Inc.*, 848 F.2d 179, 183 (Fed. Cir. 1988) (vacating holding on validity where only noninfringement finding appealed). A pessimistic patentee's halfhearted appeal on noninfringement would ensure vacatur of the invalidity judgment without substantive review. *See Commodity Futures Trading Commission v. Board of Trade*, 701 F.2d 653, 657 (7th Cir. 1983) (recognizing the possibility of an appeal by a pessimistic appellant in order to obtain vacatur). Thus, the Federal Court's practice encourages patentees to appeal noninfringement findings regardless of merit.

B. The Practice Harms The Patentee

The Federal Circuit's practice is to vacate a district court's invalidity judgment without reviewing the judgment on the merits, thereby resurrecting the patent. The practice leaves the validity of the resurrected patent subject to doubt, despite the presumption of patent validity afforded by 35 U.S.C. § 282. As Judge Lourie explained in his concurrence, "[t]he presumption of validity [of Morton's patents] has been shaken, but not destroyed." *Morton International, Inc. v. Cardinal Chemical Co.*, 959 F.2d 948, 953 (Fed. Cir. 1992)

(Lourie, J., concurring). Or, as Chief Judge Nies explained in her dissent from denial of rehearing in banc, Morton's patents have been placed "into a state of limbo, having twice had them declared invalid by the district courts, and twice having those judgments vacated . . . without any ruling on the merits." *Morton International, Inc. v. Cardinal Chemical Co.*, 967 F.2d 1571, 1577 (Fed. Cir. 1992) (Nies, C.J., dissenting from denial of rehearing in banc).

The patentee is harmed by the Federal Circuit's practice in that the resurrected patents are viewed with suspicion in the subsequent litigation. The stigma associated with the vacated, but not reviewed, invalidity holding may cause a district court in subsequent litigation to presume that vacated invalidity holding correct. Indeed, the *Morton* district court expressed "serious reservations as to Morton retrying the *Argus* case." Petition, App. C at 70a.

C. The Practice Harms The Accused Infringer

The Declaratory Judgment Act ("the Act"), which provides a remedy to persons seeking a declaration of their rights in cases of actual controversy, greatly impacted patent litigation by giving alleged infringers an opportunity to adjudicate the invalidity of asserted patents. *See Arrowhead Industrial Water, Inc. v. Ecolochem, Inc.*, 846 F.2d 731, 734-35 (Fed. Cir. 1988) ("After the Act, . . . competitors were no longer restricted to an *in terrorem* choice between the incurrence of a growing potential liability for patent infringement and abandonment of their enterprises"); *Goodyear Tire & Rubber Co. v. Releasomers, Inc.*, 824 F.2d 953, 956 (Fed. Cir. 1987) (the purpose of the Act "in patent cases is to provide the allegedly infringing party relief from uncertainty and delay regarding its legal rights"). Professor Borchard, drafter of the Act, explained the Act's importance to the alleged patent infringer:

> Having been forced into court by the patentee who necessarily relied on the validity of his patent, [the accused infringer] ought to be permitted to obtain an adjudication on the fundamental issue of validity -- important for his present and any other products which approximate the patented device -- and not be confined compulsorily and exclusively to the narrow question whether his present product infringes, regardless of his desire and demand that the patent be held invalid.

Edwin Borchard, *Declaratory Judgments* 815 (2d ed. 1941).

Under the Federal Circuit's practice, only adjudicated infringers can obtain review of the patent's validity. Therefore, that practice largely denies alleged infringers the salutary effect of the Declaratory Judgment Act.

II. THE FEDERAL CIRCUIT'S PRACTICE IS NOT JUSTIFIED

Federal Circuit opinions suggest that the court's practice is based on the mootness doctrine, judicial economy, or this Court's precedent. None of these bases, however, justifies the practice.

A. Mootness Does Not Justify The Practice

Article III of the Constitution limits federal courts to the adjudication of actual, ongoing controversies between the parties. *Deakins v. Monaghan*, 484 U.S. 193, 199 (1988). Such a controversy must be extant at all stages of federal appellate review, *Preiser v. Newkirk*, 422 U.S. 395, 401 (1975), including at "the time that a federal court decides the case." *Burke v. Barnes*, 479 U.S. 361, 363 (1987). At the time the Federal Circuit decided the appeal in this case, there was a controversy, one that continues today.

Because the Federal Circuit is not the court of last resort, its determination of noninfringement cannot moot the declaratory judgment claim of patent invalidity. *Morton*, 959 F.2d at 953 (Lourie, J., concurring); *Morton*, 967 F.2d at 1575 (Nies, C.J., dissenting from denial of rehearing in banc). Therefore, the Federal Circuit is not deprived of jurisdiction to determine the validity of a patent merely because that court has made a determination of noninfringement.

Moreover, the Federal Circuit's conclusion that its finding of noninfringement moots the validity issue is inconsistent with its own precedents. The Federal Circuit, for example, will review a finding of patent unenforceability even after finding the patent to be invalid. *See Orthopedic Equipment Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1383 (Fed. Cir. 1983). Indeed, under these circumstances, the Federal Circuit has expressly held that the unenforceability issue is not moot. *Id.* The Federal Circuit's practice also seems inconsistent with its holding that the issues of validity

and infringement are intertwined. *See Witco Chemical Corp. v. Peachtree Doors, Inc.*, 787 F.2d 1545, 1549 (Fed. Cir. 1986).[2]

B. Judicial Economy Does Not Justify The Practice

There is a distinction between mootness and the discretion of an appellate court to not consider "unnecessary" issues as a matter of "judicial convenience." *Benton v. Maryland*, 395 U.S. 784, 788-791 (1969) (discretion, not mootness, is the basis for the "concurrent sentence rule"). The term "mootness" does not properly describe the situation where courts find a case controlled by one set of issues and choose at their discretion not to address other equally dispositive issues in the case. *See* 13A Charles A. Wright, Arthur R. Miller, & Edward E. Cooper, *Federal Practice & Procedure: Jurisdiction* § 3533 at 214 (2d ed. 1984). In

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[2] The Federal Circuit's practice has no precedent in the non-patent cases of the other intermediate appellate courts. The ABA has searched the case law of each of these other circuits and has been unable to find any non-patent case in which a declaratory judgment was vacated merely because the opposing party was denied the relief it requested. Indeed, the courts that have looked to non-patent analogies have required adjudication of declaratory judgment counterclaims for invalidity. *Trico Products Corp. v. Anderson Co.*, 147 F.2d 721, 722-23 (7th Cir. 1945) (reversing dismissal of declaratory judgment counterclaim for invalidity based on analogy to, *inter alia*, claim for specific performance of contract and counterclaim for cancellation).

his *Morton* concurrence, Judge Lourie recognized that the Federal Circuit's practice could not be based on mootness, but must rather be based on judicial discretion motivated by concerns of "judicial economy." *Morton*, 959 F.2d at 953-54 (Lourie, J., concurring). That explanation fails, however, for at least three reasons.

First, the Federal Circuit's practice is the antithesis of discretion. Instead, it has evolved into a *per se* rule. *Morton*, 967 F.2d at 1574 (Nies, C.J., dissenting from denial of rehearing in banc) ("'one-size-fits-all' approach"). As this Court has explained, "to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which alone can justify its exercise . . . ." *United States ex. rel. Steinmetz v. Allen*, 192 U.S. 543, 563 (1904).

Second, the Federal Circuit's practice can be based on discretion to avoid deciding unnecessary issues only if determination of noninfringement renders the invalidity issue redundant. *See Morton*, 967 F.2d at 1576-77 (Nies, C.J., dissenting from denial of rehearing in banc). *Contra* Howard T. Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369, 381 (1987). But the invalidity issue is not automatically rendered redundant by the determination of noninfringement. For example, the noninfringement finding may not address all the patent claims or all the alleged infringer's *potentially* infringing devices. Or the alleged infringer and other competitors may wish to redesign their products to fall squarely within the claims of the patent, which acts as a "scarecrow" until invalidated. *See Bresnick*, 139 F.2d at 242.

Declaratory judgment counterclaims of patent invalidity serve "a useful purpose, since otherwise the plaintiff's action might be determined solely on the ground of noninfringement, leaving defendant still without an adjudication as to the question of validity." 3 James W. Moore & Richard W. Freer, *Moore's Federal Practice* ¶ 13.07 (2d ed. 1992). As a result, courts tend to defer a ruling on whether a counterclaim for patent infringement is "wholly redundant" until "it can be more clearly seen whether affirmative relief is needed by a defendant." *Leach v. Ross Heater & Mfg. Co.*, 104 F.2d 88, 92 n.1 (2d Cir. 1939) (Clark, J., concurring). In his definitive work on declaratory judgements, Professor Borchard explained, "[s]uch a course seems advisable, because, while repeated dismissals without prejudice are no longer possible, the defendant's protection should not rest so exclusively in the discretion of the judge before trial. Only the trial can fully disclose what affirmative relief is necessary." Borchard, *supra*, at 814. Once the district court has decided that the invalidity issue is not redundant and entered judgment of invalidity, and the patentee has not sought dismissal of the declaratory judgment claim as redundant, the invalidity judgment cannot be rendered redundant by an appellate determination of noninfringement. *Morton*, 967 F.2d at 1577 (Nies, C.J., dissenting from denial of rehearing in banc).

Third, the Federal Circuit's invocation of judicial economy to support its practice is, at best, false economy. The Federal Circuit's practice harms the public and wastes the resources spent by the litigants and the district court at trial, by the litigants on the appeal of the invalidity issue, and by the litigants and

courts in subsequent litigation, as this case vividly illustrates.

The patentee, Morton, has brought three separate patent infringement actions on two of its patents. In the first action, Morton filed a patent infringement action against Argus Chemical Corporation. After an eight-day bench trial, the *Argus* district court held the patents invalid and not infringed. On appeal, the Federal Circuit affirmed the noninfringement finding and vacated the invalidity judgment. *Morton Thiokol, Inc. v. Argus Chem. Corp.*, 873 F.2d 1451 (Fed. Cir. 1989) (unpublished). In the second action, Morton charged Cardinal Chemical Company with patent infringement, and after a five-day bench trial, the *Cardinal* district court declared the patents invalid and found them not infringed. Once again, the Federal Circuit affirmed the noninfringement finding and vacated the invalidity judgment. *Morton*, 959 F.2d at 952.

In the third action, Morton has asserted its twice resurrected patents against Atochem North America, Incorporated. *Morton International, Inc. v. Atochem North America, Inc.*, No. 87-60-CMW (D. Del.). The *Atochem* case has been stayed pending the outcome of the *Morton* case.

"[P]atent litigation is a very costly process." *Blonder-Tongue*, 402 U.S. at 334. "[P]atent litigation has become an increasingly inefficient, ineffective and undesirable means of resolving patent-related disputes." The Advisory Commission on Patent Law Reform, *A Report to the Secretary of Commerce*, 78 (1992). "[O]ne of the most significant problems facing the United States

patent system is the spiraling cost and complexity associated with the enforcement of patent rights." *Id.* at 75. Had the Federal Circuit reviewed the invalidity judgment in the *Argus* case, it is possible that neither Morton, Cardinal (who claims to have spent over one million dollars in *Morton*), the *Cardinal* district court, nor the Federal Circuit would have had to expend their resources in *Morton*. Likewise, the *Atochem* case may have been barred by the Federal Circuit's review of either the *Argus* or *Morton* invalidity judgments. Thus, the Federal Circuit's practice harms the public and risks wasting the resources of patentees, alleged infringers, district courts and the Federal Circuit alike in unnecessary repetitive litigation.

This repetitive litigation hits the already overburdened district courts especially hard. *Wang*, 793 F. Supp. at 678 (the Federal Circuit's practice wastes judicial resources by "having two trial courts consider the same validity issue"). And to the injury of unnecessary, repetitive, complex, patent litigation, the Federal Circuit's practice adds the insult of vacatur of the district court's judgment. *Morton*, 967 F.2d at 1577 n.9 (Nies, C.J., dissenting from denial of rehearing in banc).

C. This Court's Precedent Does Not Justify The Practice

In his concurrence in *Vieau v. Japax, Inc.*, 823 F.2d 1510, 1517 (Fed. Cir. 1987), the only opinion explaining the basis of the Federal Circuit's practice, Judge Bennett relied on three of this Court's decisions, *Electrical Fittings Corp. v. Thomas & Betts Co.*, 307 U.S. 241 (1939), *Altvater v. Freeman*, 319 U.S. 359 (1943), and

Deposit Guaranty National Bank v. Roper, 445 U.S. 326 (1980). None of these decisions, however, justifies the practice.

In *Electrical Fittings*, the district court held a patent claim valid, but not infringed. The accused infringer appealed from the court's judgment, seeking to eliminate the holding of validity. This Court held that the accused infringer was entitled to have the holding of validity eliminated from the judgment as immaterial.

In *Altvater*, the patent owner sued for specific performance of a patent license agreement, and the licensees counterclaimed for a declaratory judgment of patent invalidity. The district court held that (1) there was no infringement; (2) the licensees were not breaching the license agreement; and (3) the patents were invalid. The court of appeals affirmed the noninfringement finding, ruled that there no longer existed a justiciable controversy between the parties, and vacated the invalidity judgment. This Court granted certiorari because of the appellate court's apparent misinterpretation of *Electrical Fittings*, and ruled that:

> [*Electrical Fittings*] was tried only on bill and answer. The District Court adjudged a claim of a patent valid although it dismissed the bill for failure to prove infringement. We held that the finding of validity was immaterial to the disposition of the cause and that the winning party might appeal to obtain a reformation of the decree. To hold a patent valid if it is not infringed is to decide a hypothetical case. But the situation in the present case is quite different.

> *We have here not only bill and answer but a counterclaim. Though the decision of non-infringement disposes of the bill and answer, it does not dispose of the counterclaim which raises the question of validity.*

Altvater, 319 U.S. at 363 (emphasis added; footnote and citations omitted).

In *Deposit Guaranty*, the Court relied on *Electrical Fittings* for its holding that the appellate courts retain jurisdiction on appeal, notwithstanding the district court's entry of judgment in favor of the appellant, if the appellant retains a stake in the appeal satisfying the case or controversy requirement. Per the *Deposit Guaranty* Court, the critical fact in *Electrical Fittings* was that the determination of patent validity, even though raised only as a defense, was embodied in the judgment. 445 U.S. at 335. As long as that determination remained in the district court's judgment, the controversy was still live:

> In *Electrical Fittings*, the petitioners asserted a concern that their success in some unspecified future litigation would be impaired by *stare decisis* or collateral-estoppel application of the District Court's ruling of patent validity. This concern supplied the personal stake in the appeal required by Article III. It was satisfied fully when the petitioners secured an appellate decision eliminating the erroneous ruling from the decree. After the decree in *Electrical Fittings* was reformed, the then unreviewable judgment put an

end to the litigation, mooting all substantive claims.

Deposit Guaranty, 445 U.S. at 337.

Altvater and *Deposit Guaranty* recognized a significant distinction between an alleged infringer's right to a declaratory judgment of invalidity, at issue in *Altvater*, and a mere defense of invalidity, at issue in *Electrical Fittings*. Accordingly, the *Altvater* Court held that a declaratory judgment of patent invalidity may not be summarily vacated as moot *solely* because of a noninfringement finding.

The *Altvater* Court stated that "the issues raised by the present counterclaim were justiciable and that the controversy between the parties did not come to an end on the dismissal of the bill for noninfringement, since their dispute went beyond the single claim and the particular accused devices involved in that suit." 319 U.S. at 363-64 (citation omitted). The Federal Circuit interprets this dicta in *Altvater* to stand for the proposition that the controversy that precluded vacating the invalidity judgment depended upon the presence of additional claims or devices not involved in the noninfringement finding. *See Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 634 n.2 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988); *Vieau*, 823 F.2d at 1518 (Bennett, J., concurring). As a result, the Federal Circuit has elevated the *Altvater* dicta to a practice that conflicts with the *Altvater* holding. As noted by Chief Judge Nies, *Altvater* "does not support the holding of *Vieau*, [and] we should overrule *Vieau* . . . ." *Morton*, 967 F.2d at 1572 (Nies, C.J., dissenting from denial of rehearing in banc).

Neither mootness, judicial economy, nor this Court's precedent require the Federal Circuit to vacate, without review, a declaration of patent invalidity merely because the Federal Circuit has determined that the patent is not infringed. Therefore, the Federal Circuit should not refuse to consider a declaratory judgment claim or counterclaim for patent invalidity merely because it determines that the patent was not infringed.

CONCLUSION

For the foregoing reasons, *amicus* American Bar Association urges that the decision of the Federal Circuit, insofar as it vacates the district court's invalidity judgment without review, be reversed, and this case be remanded to the Federal Circuit for review on the merits of the declaratory judgment of invalidity.

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